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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/090,758      | 06/17/98    | DUVALL               | T 2543-28-93        |

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IM62/1014

EXAMINER

MULCAHY, P

ART UNIT

PAPER NUMBER

1713

5

DATE MAILED: 10/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/098,758**

Applicant(s)  
**Duvall**

Examiner  
**Peter D. Mulcahy**

Group Art Unit  
**1713**



☒ Responsive to communication(s) filed on Jun 17, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) 10 and 11 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-9, drawn to a polymeric composition, classified in Class 524, subclass 392.

II. Claims 10 and 11, drawn to a stabilizer composition, classified in Class 252, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an additive composition for a polycarbonate or polyester composition and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be

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used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and have acquired a separate status in the art because of their recognized divergent subject matter, , restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Didrick on October 1, 1999 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(b) as anticipated by Kugele et al., U.S. Patent No. 4,665,114.

This patent teaches PVC compositions which are stabilized with applicants' instantly claimed mercaptan compound. See column 14, lines 10+. This patent further teaches incorporations which fall within the scope of applicants' instantly claimed Lewis acids. See column 16, lines 54+. In view of this disclosure, applicants' claims are not novel.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kugele et al., U.S. Patent No. 4,665,114.

In the event that one of ordinary skill in the art would not immediately envisage each of applicants' instantly claimed limitations, then the claimed compositions are rendered prima facie obvious from this disclosure. This patent teaches each of applicants' instantly claimed ingredients and suggests to one of ordinary skill in the art that they may be used in combination as claimed. Such a suggestion provides sufficient motivation for

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one of ordinary skill in the art to combine the ingredients as claimed.

Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as anticipated by Kornbaum.

This patent teaches PVC compositions which are stabilized with applicants' instantly claimed mercaptan compounds. See specifically column 2, line 60+. Applicants' instantly claimed zinc carboxylate compounds are shown at column 3, lines 15+. In view of this disclosure, applicants' claims are not novel.

Claims 1-3 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornbaum.

In the event that one of ordinary skill in the art would not immediately envisage each of applicants' instantly claimed limitations, then the claimed compositions are rendered prima facie obvious from this disclosure. This patent teaches each of applicants' instantly claimed ingredients and suggests to one of ordinary skill in the art that they may be used in combination as claimed. Such a suggestion provides sufficient motivation for one of ordinary skill in the art to combine the ingredients as claimed.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by Bae et al.

This patent teaches polyvinyl chloride polymer compositions which are stabilized with the instantly claimed zinc compounds.

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See specifically column 5, lines 43+. The incorporation of the claimed mercaptan compounds is taught at columns 7 and 8. In view of this disclosure, applicants' claims are not novel.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bae et al.

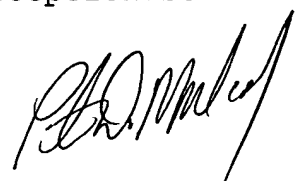
In the event that one of ordinary skill in the art would not immediately envisage each of applicants' instantly claimed limitations, then the claimed compositions are rendered prima facie obvious from this disclosure. This patent teaches each of applicants' instantly claimed ingredients and suggests to one of ordinary skill in the art that they may be used in combination as claimed. Such a suggestion provides sufficient motivation for one of ordinary skill in the art to combine the ingredients as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Monday through Thursday from 7:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph L. Schofer, can be reached on (703) 308-2452. The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

P. Mulcahy:cdc  
October 4, 1999



PETER D. MULCAHY  
PRIMARY EXAMINER  
GROUP 1500